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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,543	03/19/2002	Masanori Tohnishi	46/168	6952

20736 7590 04/08/2003  
MANELLI DENISON & SELTER  
2000 M STREET NW SUITE 700  
WASHINGTON, DC 20036-3307

EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 04/08/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/088,543

Applicant(s)

TOHNISHI ET AL.

Examiner

Venkataraman Balasubramanian

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 & 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I, claims 1-6 where Q<sup>1</sup>, Q<sup>2</sup>, Q<sup>3</sup>, and Q<sup>4</sup> are all carbons in Paper No. 10 is acknowledged. Claims 1-6 will be examined to the extent they embrace the elected subject matter.

The traversal is on the ground(s) that that the International Search Authority did not find lack of unity and therefore the restriction requirement is not proper. This is not found persuasive because of the following reasons:

1. The criteria for restriction requirement for 371 application entering the National Stage is not whether International Authority did make a lack of unity or did not make a lack of unity.
2. As noted in Paper # 8, The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The requirement for unity of invention is two-fold: (1) common utility and (2) sharing a substantial structural feature disclosed as being essential to the utility.

Group I-VII are independent and distinct from each other because they are directed to dissimilar compounds with varying heteroaryl cores namely phenyl, isomeric pyridinyl, isomeric pyrimidinyl, isomeric pyridazinyl, pyrazinyl, isomeric triazinyl, and tetrazinyl with same disubstituted amide side chains, which are not art recognized equivalent of each other. Consequently, the groups are distinct

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and require separate prior art searches. They can be made and used independently. Art, which may render obvious or anticipate one of the groups would not necessarily do the same for the other group as evident from the references cited in the Information Disclosure Statement. See EP 919 542 and EP 799 825. Each can support a patent, as the compounds of each group are capable of being utilized alone not in combination with other members listed in the Markush group. The sole feature common to the groups which does not vary is the presence of C=C in the hetero aryl ring bearing the diamide substituents which by itself cannot be considered to define patentable contribution over prior art given such fragment with substituents is known as evidenced by the art cited in the description and therefore would not constitute a special technical feature as defined by PCT Rule 13.2.

The common utility requirement is also not met with as seen in the prior art cited above the compounds can be used either as insecticides or herbicides. Thus more than one utility such as herbicides, or insecticides recited in the references cited in the Information Disclosure Statement of structurally related compounds negates the common distinct utility requirement.

3. In addition, it would be serious search burden to classify and search all these groups, which is mandatory groups with given limited time per application.
4. In addition, applicants have not traversed the restriction requirement on the ground that the compound with the above said variable cores are not patentably distinct and have not submitted any evidence or identified such evidence now of

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record showing the compounds to be obvious variants or clearly admitted on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Following reasons apply. Any claim not specifically rejected is rejected as being dependent on a rejected claim.

1. Claims 1-4 recite the term "derivative" which render these claims indefinite as the term "derivative" implies more than what is being positively recited. Note the term "derivative" can include any or all organic compound derived from the core structure, Thus it is not clear what is included or excluded. Replacement of the term "derivative" with "compound" is suggested.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Tohnishi et al, EP 0 919 542 A2.

Tohnishi et al. teaches several phthalic acid diamide useful as insecticides, which include compounds claimed in the instant claims. See page 3, formula I and note the definition of various variable substituents. See the entire document for the process of making these compounds, compounds made and the method of use as insecticides. See pages 27-121, Table 1 and Table 2 for compounds made especially compounds 1973-1987. See Table 4 on pages 130-191 for testing of these compounds.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tohnishi et al, EP 0 919 542 A2.

Teachings of Tohnishi et al as discussed in the above 102 rejection is incorporated herein. As noted above, Tohnishi et al. teaches several phthalic acid diamide useful as insecticides, which include compounds claimed in the instant claims.

Instant claims differ from Tohnishi et al. in requiring variously substituted aromatic diamide, in addition those exemplified by Tohnishi et al.

However Tohnishi et al. teaches the equivalency of exemplified substituents on the aromatic ring, and the two amide groups with those recited in the definition of the generic compound of formula I. See page 3, formula I and note the definition of various variable substituents.

Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to make compounds variously substituted in aromatic ring, and the amide groups as permitted by the reference and expect resulting compounds (instant compounds) to possess the uses taught by the art in view of the equivalency teaching outline above.



References cited in the Information Disclosure Statements (paper # 3 and 9) are made of record.

**Conclusion**

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is Mukund Shah whose telephone number is (703) 308-4716.

The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

  
Venkataraman Balasubramanian

4/5/2003